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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,580	07/11/2003	Thomas L. Foster	10922/51	3677
757 7590 04/03/2009 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER				
NGUYEN, TUAN VAN				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
04/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/617,580

Applicant(s)

FOSTER ET AL.

Examiner

TUAN V. NGUYEN

Art Unit

3731

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11,13-17,20-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 9,23 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,12-22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 2, 5-11, 13-17, 20-23 and 25-29 are pending in this present application. Claims 9, 23 and 27-29 have been withdrawn.
2. This Office action is in response to the amendment filed on 1/29/09.

Response to Amendment

3. Applicant's remarks with respect to the rejection of all claims under 35 U.S.C. § 103(a) have been fully considered but they are moot in view of new ground of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. **Claims 1, 2, 5-7, 12-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva et al (U.S. 5,885,258) in view of Schaefer et al. (US 7,033,374) further in view of Jones et al (U.S. 5,843,050).**
7. As to claims 1, 7, 13-14 and 18-21, Sachdeva discloses (see Figs. 1A-1D and 11) a retrieval device made from shape-memory alloy comprising: a cannula 11 comprising a proximal portion; a distal portion; a grasper portion, which includes plurality of slots 12, located at the distal portion of the cannula 11; and a sheath 13 for controlling the grasper portion (col. 3, lines 32-50). Sachdeva further discloses a delivery tube 63 or an introducer sheath 63, a tool or grasper 62 located at the distal end of cannula 61, wherein the grasper and the cannula is a one piece unitary component (col. 4, lines 40-50). Further, Sachdeva discloses (Fig. 11) the cannula structure 201 can have zigzag cut extending through the external surface of the distal portion to provide flexibility to the distal portion of the cannula (see col. 6, lines 16-27). Sachdeva discloses the invention substantially as claimed except for the pattern of the cut at the distal portion of the cannula comprises a spiral cut. However, Schaefer discloses (see col. 4, lines 58-60) that spiral cut tubes to provide flexibility to a tubular structure is old and well known in the art. Therefore, given the teachings of Schaefer, it would have been obvious to one of ordinary skill in the art to replace the zigzag cut with the spiral cut as disclosed by Schaefer

because it has been held that substitution of one known element for another to obtain predictable results is old and well known in the art. The modified device of Sachedeva discloses the invention substantially as claimed except for the at least two sections with spiral cut wherein spiral cut of each section having different pitch.

8. However, Jones discloses (see Fig. 3) a microcatheter 10 having tubular element 30 wherein a distal portion of tubular 30 includes at least two sections with spiral cut wherein spiral cut of each section having different pitch to provide a high degree of flexibility to facilitate negotiation of small, tortuous vessels (see Abstract and col. 5, lines 1-40). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the spiral cut, as disclosed by Jones, into the distal portion of the cannula of Sachedva/Schaefer so that it too would have the same advantage.
9. As to claims **2, 5, 6, 15-17, 22, and 25-26**, the modified device of Sachdeva discloses the invention substantially as claimed except for specifically disclosing the dimensions that claimed by the applicant. It would have been obvious to one having ordinary skill in the art to design the spiral cut is taken about 60 to about 80 degrees from the longitudinal axis of the cannula and the width of the spiral cut is about 0.001 to about 0.002 inches wide, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Extrinsic evidence, Pinchuk (US 4,960,410) discloses spiral cut is

taken about 25 to about 85 degrees from the longitudinal axis of the cannula (col. 3, lines 58-60).

10. As to claims **10, 11 and 20**, Sachedeva discloses the device can be used in urethra (col. 4, line 33) and it further includes an optical fiber 106, 111 (Figs. 10A & 10C, col. 5, lines 60-65 and col. 6, lines 10-14), an irrigation system (col. 1, lines 53-55), and a laser system (claim 11).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
4/1/09